

Application No. 10/674,971
Amendment dated May 16, 2011
Reply to Final Office Action of February 16, 2011

REMARKS

Applicant amended independent claim 29 to further define Applicant's claimed invention.

I. Request for withdrawal of finality.

In the Office Action, the Examiner indicated that the present Office Action was final because "[a]ll claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office Action if they had been entered in the application prior to the entry under 37 CFR 1.114." (Office Action, page 4, lines 5-8). Applicant respectfully disagrees with the Examiner's decision to make this action final and requests withdrawal of the finality of the present Office Action pursuant to MPEP § 706.07(d).

The MPEP permits a first action to be made final only when "all claims of the new application (1) are drawn to the same invention claimed in the earlier application; and (2) would have been properly finally rejected on the grounds and art of record in the next Office Action if they had been entered in the earlier application." (MPEP § 706.07(b), p. 700-84, col. 1 (Rev. 6, Sep. 2007) (emphasis added)). Accordingly, both grounds must be satisfied in order to make a first action final. Applicant respectfully submits that neither ground has been satisfied.

A. All the claims are not drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR § 1.114.

In the Amendment dated November 4, 2010 ("November 2010 Amendment"), Applicant amended dependent claims 37 and 48 to each recite "rotating the implant at least one half turn into the opening." The MPEP defines the phrase "same invention" to mean "an invention drawn to identical subject matter." (See MPEP § 804(II), p. 800-19, col. 1 (Rev. 5, Aug. 2006)). The amendment to the claims presented by the November 2010 Amendment changed the scope of the claims so that they are not drawn to the "same invention" as claimed prior to entry of the November 2010 Amendment.

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For example, by adding a requirement that the implant is rotated "at least one half turn" in claims 37 and 48, implants that are rotated less than one half turn into the opening would be outside of the scope of claims 37 and 48.

Applicant respectfully submits that the subject matter of the claims as amended by the November 2010 Amendment is not identical to the subject matter of the claims as they existed prior to the November 2010 Amendment.

B. All the claims could not have been finally rejected on the grounds and art of record in the next Office Action if they had been entered in the application prior to the entry of the submission under 37 CFR § 1.114.

In the Final Office Action dated August 4, 2010, the Examiner rejected claims 37 and 48 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,714,469 to Kenna ("Kenna"). In the present Final Office Action, the Examiner rejected claims 37 and 48 under 35 U.S.C. § 103(a) over Kenna in view of International Publication No. WO 98/48738 to Crozet ("Crozet") (via related U.S. Patent No. 6,855,168).

Applicant respectfully submits that the Examiner's replacement of the 35 U.S.C. § 102(b) rejection over Kenna with the 35 U.S.C. § 103(a) rejection over Kenna in view of Crozet is *prima facie* evidence that not all of the claims could have been finally rejected on the grounds and art of record in the next Office Action if they had been entered in the application prior to entry of the submission under 37 C.F.R. § 1.114. Therefore, Applicant respectfully submits that the finality of the present Office Action is premature and requests the Examiner to withdraw finality of the present Office Action pursuant to MPEP § 706.07(d) so that Applicant may be given a fair opportunity to address the new rejection raised for the first time by the Examiner in this Office Action.

II. Remarks in response to the Examiner's rejections.

In the Final Office Action, the Examiner rejected claims 29, 30, 33-36, 39-41, 44-47, 50-59, 62, 63, and 65-67 under 35 U.S.C. § 102(b) as being clearly anticipated by U.S. Patent No. 4,714,469 to Kenna ("Kenna"). Applicant respectfully traverses the rejection on the ground that Kenna does not disclose each and every recitation of independent claims 29 and 39.

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A. Independent Claim 29.

- (1) Arcuate upper and lower surfaces "from the lateral side to the medial side along the maximum width."

Independent claim 29, as amended, recites that "the upper and lower surfaces being arcuate from the lateral side to the medial side along the maximum width of said implant and in a plane transverse to a mid-longitudinal axis of the implant."

Kenna discloses an implant having first "a first surface 1 and a second surface 2" (e.g., upper and lower surfaces, respectively); "curved portion 4" (e.g., lateral side), "straight side 6" (e.g., medial side), and arcuate "protuberances 5." (See Kenna, col. 3, lines 34-35; 39, 55; Figs. 2 and 3). Figs. 2 and 4 of Kenna indicate that upper and lower surfaces 1, 2 face up and down, respectively, while sides 4 and 6 face left and right, respectively. The Examiner contends that "lateral and medial sides as claimed may alternatively be viewed as including the upper and lower flat surface portions of the Kenna implant." (Office Action, page 2, lines 20-21). The MPEP sets forth that the Examiner must use the "broadest reasonable interpretation." (MPEP § 2111, p. 2100-37, col. 2 (Rev. 7, Sept. 2008) (emphasis added)).

Surfaces 1, 2, 4, and 6 are separate surfaces as described by Kenna. In particular, surfaces 4, 6, are "sides," while surfaces 1, 2, are *prima facie* upper and lower surfaces because they are oriented at 90° to sides 4, 6. Accordingly, Applicant respectfully submits that it is unreasonable to attempt to construe upper and lower facing surfaces that are oriented 90° to the sides as something other than an upper or lower surface, particularly when the claims treat these surfaces as separate elements, and the Kenna disclosure treats them as separate surfaces. Moreover, even the Examiner's own language in the rejection indicates that surfaces 1, 2 are better characterized as upper and lower surfaces rather than side surfaces. (See Office Action, p. 2, line 21; and p. 3, line 1).

Assuming, *arguendo*, that the Examiner's interpretation was reasonable, Kenna does not teach or suggest several other elements of the method recited in independent claim 29. In particular, Fig. 2 of Kenna shows that the arcuate protuberance 5 of upper and lower surfaces 1, 2 does not extend from curved side 4 to straight side 6.

Accordingly, neither upper surface 1 nor lower surface 2 is arcuate "from the lateral side to

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the medial side along the maximum width of said implant and in a plane transverse to a mid-longitudinal axis of the implant" as recited in independent claim 29.

(2) "Positioning the leading end."

Independent claim 29 recites "positioning the leading end of the implant so that at least a portion of the implant proximate the leading end between the medial side and the mid-longitudinal axis overlies the apophyseal rim without substantially protruding from the spine." Kenna teaches that "[w]hen the grooves are drilled each drill bit is removed and replaced by a spacer to maintain the spaces between the vertebrae." (Kenna, col. 5, lines 66-68). Fig. 4 of Kenna does not show that the leading ends of the implants are positioned such that portions of the implants proximate the leading end between the medial side and the mid-longitudinal axis overlie the apophyseal rim. Accordingly, Kenna does not disclose this element of independent claim 29.

B. Independent claim 39.

(1) Each of the lateral and medial sides is "at least in part straight."

Independent claim 39 recites that "each of the lateral and medial sides" of the first and second implants is "at least in part straight in a direction from the leading end to the trailing end along at least a portion of the length" of the implant. The Examiner contends that "said upper and lower flat surface portions are straight along the implant length." (Office Action, page 3, lines 1-2). Applicant is not requiring the upper and lower surfaces to have the straight portion, but both of the medial and lateral sides to have the straight portion. Kenna fails to disclose this feature. Fig. 3 of Kenna shows that side 4 of the implant is curved and side 6 of the implant is straight. Accordingly, Kenna does not disclose an implant with lateral and medial sides as recited in independent claim 39.

(2) "Positioning the leading end."

Independent claim 39 recites "positioning the leading end of each implant so that at least a portion of the implant proximate the leading end between the medial side and the mid-longitudinal axis overlies the apophyseal rim without substantially protruding from the spine." Kenna teaches that "[w]hen the grooves are drilled each drill bit is removed and

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replaced by a spacer to maintain the spaces between the vertebrae." (Kenna, col. 5, lines 66-68). Fig. 4 of Kenna does not show that the leading ends of the implants are positioned such that portions of the implants proximate the leading end between the medial side and the mid-longitudinal axis overlie the apophyseal rim. Accordingly, Kenna does not disclose this element of independent claim 39.

Applicant submits that Kenna does not disclose each and every recitation of independent claims 29 and 39. Accordingly, Applicant submits that the rejection of independent claims 29 and 39, and claims 30, 33-36, 40, 41, 44-47, 50-59, 62, 63, and 65-67, dependent from one of independent claims 29 and 39, or claims dependent therefrom, under 35 U.S.C. § 102(b) over Kenna has been overcome.

The Examiner rejected claims 31, 32, 42, 43, 64, and 68 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Kenna and U.S. Patent No. 5,192,327 to Brantigan ("Brantigan"); and rejected claims 37, 38, 48, and 49 under 35 U.S.C. § 103(a) as being unpatentable over Kenna in view of Crozet. Applicant submits that the rejections of claims 31, 32, 37, 38, 42, 43, 48, 49, 64, and 68 are rendered moot at least because these claims depend from an allowable independent claim, or claims dependent therefrom.

Applicant submits that independent claims 29 and 39 are patentable and that dependent claims 30-38, 40-59, and 62-68 dependent from independent claim 29 or 39, or claims dependent therefrom, are patentable at least due to their dependency from an allowable independent claim.

In view of the foregoing remarks, it is respectfully submitted that the claims, as amended, are patentable. Therefore, it is requested that the Examiner reconsider the outstanding rejections in view of the preceding comments. Issuance of a timely Notice of Allowance of the claims is earnestly solicited.

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To the extent any extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this reply, such extension is hereby respectfully requested. If there are any fees due under 37 C.F.R. §§ 1.16 or 1.17 which are not enclosed herewith, including any fees required for an extension of time under 37 C.F.R. § 1.136, please charge such fees to our Deposit Account No. 50-3726.

Respectfully submitted,

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